

**REMARKS/ARGUMENTS**

Claims 1-22 are pending. Claims 1, 9-11, 12 and 20-22 were amended, claims 8 and 19 were canceled, and claim 23 was added. Consequently, claims 1-7, 9-18, and 20-23 remain pending.

The specification has been amended to provide cross-reference to co-pending applications, as requested by the Examiner. Independent claims 1 and 12 have been amended to incorporate the recitations of canceled claims 8 and 19, respectively. Claims 9-11 and 20-22 were amended to correct claim dependencies. New claim 23 was added to further claim aspects of the present invention. Support for the combination of action list items may be found in the Specification of page 14, lines 6-18.

**§103 Rejection**

The Examiner rejected claims 1-9 and 12-20 under 35 USC §102 (b) as being anticipated by Safia (US 6,167,469). Applicants respectfully traverse the rejection.

The present invention provides a method and system for allowing a user to select actions to be taken by a server when uploading images from a hand-held image capture device. The server maintains user accounts that also include one or more action lists. As described in the Specification with respect to FIG. 1:

Each user account 40 in the database 20 may also include one or more action lists 48. According to the present invention, an action list 48 includes one or more items representing actions that the gateway server 18 should take with respect to uploaded images, such as where to store and/or send the images from a particular user or camera, for instance. As explained further below, the action list 48 stored on the database 20 under a user's account 40 are automatically downloaded to the user's camera 14 during a connection with the gateway server 18 and stored on the camera 14. When the user initiates an image upload, the

action list 48 is displayed to the user so the user may easily select what actions the gateway server 18 should take with respect to the images by selecting the displayed action list items.

Examples of action list items include specifying that the uploaded images should be stored on the entity-specific photo website, sending the images to a list of email addresses, or even performing some type of analysis or calculation on the image data, for instance.

In a further aspect of the present invention, an action list item is not limited to instructing the gateway server 18 to perform actions only within the photo-sharing service 16. Rather, an item in the action list 48 may also instruct the gateway server 18 to perform actions outside of the photo-sharing service 16, such as storing the images in an external database 49 of the entity 12. For instance, in the example where the entity 12 is a company, some users of the company's cameras 14 could have action lists 48 instructing the gateway server 18 to store uploaded images to the company's database, rather than to the company's photo-sharing site 22. Based on the action lists 48 and customization, the gateway server 18 may be programmed to automatically perform predefined tasks, such as creating new web albums, or a new page within an existing album, parse the images to extract sound files or other metadata, print images and mail them to designated addresses, and so on.

In a preferred embodiment, the action lists 48 may be created via several methods. In one method, the action list is created by the photo-sharing service 16 the first time the user's camera establishes a connection. That is, a default action list 48 is automatically created based on the entity ID when a user account 40 is first created. In a hierarchal entity relationship where the entity 12 is a company, a default action list 48 may be created to implement a workflow specified by the entity 12. In a hierarchal relationship where the entity 12 is camera manufacturer, for instance, a default action list 48 may be created instructing the gateway sever 18 to store the user's images in a simulated "shoebox" on the entity-specific photo-sharing site 20. The user may then go online and create albums from the images in the shoebox as desired.

Another method is for the user to create the action list 48 online on the entity-specific photo-sharing site 20. The action list 48 may be created manually on the website 20 by the user navigating to the site 20 using a web browser 24, accessing her account, and manually creating the action list 48 or editing the action list 48 on the entity-specific site 22. The action list 48 may also be created automatically on the website 20 in response to user actions performed on the website, such as printing images, or creating a web album. Alternatively, after performing an action, the user may be prompted whether they would like this action added to his or her action list 48. If so, the user clicks a check-box and the item is added the action list 48. In a preferred embodiment, any action list 48 created and edited on the photo-sharing site 20 are downloaded to the every time the camera 14 connects to the photo-sharing service 16 and made available for user selection on the camera 14 during the next upload.

Yet another method for creating an action list 48 is to allow the user to create the action list on the camera 14. The user may manually create an action list 48 by “typing” in predefined items on the camera. The user may also type in an email address as an action list item whereby when that item is selected, the uploaded images are stored as a web album on the entity-specific photo-sharing website 22 and the server 18 sends a notification to the specified recipient containing the URL to the web album page.

Referring now to claims, amended independent claims 1 and 12 now recite that the action list is downloaded from the server to the image capture device. It is respectfully submitted that Safai fails to teach or suggest the combination of features recited in the amended claims.

#### Safai

In contrast to the present invention, Safai is directed to a method and apparatus for transporting digital images from a digital camera to a server. The digital camera executes a transport application that enables a user to send one or pictures from the camera to one or more external addresses (column 7, lines 31-37). When the transport application is launched, a top-level view of the functions available in the transport application is displayed to the user (column 8, lines 21-27). As shown in figure 4A, the functions include selecting address, choosing a photo, recording a voice message, and sending a photo.

Unlike the action list recited in the claims of the present invention, Safai’s top-level menu is hardcoded into the software application. That is, each of the applications that are executed on the camera display their own top-level menus. Safai’s camera is incapable of receiving an “action list” that is downloaded from the server, as recited in claims 1 and 12.

In addition, the functions displayed in Safa’s top-level menus are functions related to the respective application. By contrast, in the present invention, the action list downloaded from the

server to the camera is unbound by the functions of any particular software application in the camera. Incidentally, it should be noted that the functions displayed in Safa's top-level menu are functions that are primarily performed *in the camera*, e.g., selecting address, choosing a photo, recording a voice message, and sending a photo. The only function performed by the server is parsing the address and sending the uploaded photo to that address. In the present invention, the actions displayed in the action list are primarily performed *by the server*, such as storing the image at a specified location, and analyzing or performing calculations on the images.

With respect to figures 4 at 15, the Examiner cited figure 4f, item 466 of Safai for teaching the step of providing the action list with a store item that instructs the server to store the images within the photo-sharing service website. With respect to claims 5 and 16, the Examiner cited figure 4E, element 456 of Safai for teaching the step of providing that the store item instructs the server to store the images to a location external to the photo-sharing website.

However, element 466 in figure 4F merely shows an address field for the user to specify the e-mail address of where the server should e-mail an uploaded image, and element 456 in figure 4E shows a confirmation box that displays an address, the number of photos to be sent to that address, and an indication whether a voice message is attached. It is respectfully submitted that providing menu items that allows a user to specify an e-mail address, as shown in figures 4F and 4E, fails to teach or suggest providing an action list with a store item that instructs the server where to store the images within the photosharing service website, since an e-mail address is not a storage location, and the act of emailing an image is not equivalent to the act of storing the image a specified location.

With respect to claims 7 and 18, the Examiner cited figure 4B for teaching step of allowing the user to create the action list on image capture device. However, figure 4B, shows a display that allows a user to type-in an e-mail address using a virtual keyboard. As discussed above, Safai's menus and displays are displayed by a particular application executing on the device, which are hardcoded in the applications. Applicant has studied Safai and can find no teaching of an application that enables the *user to create* a list of actions *on the image capture device* that are to be performed by the server, as recited in claims 7 and 18.

With respect to claims 19 and 20, the Examiner cited column 15, lines 61-27 for teaching creating user account for user the first time the image capture device establishes communication with the server and creating a default action list for the user. This rejection is fully understood insofar as figure 4F just shows a "send message screen" that has nothing to do with establishing user accounts or for creating a default action list.

### §103 Rejection

The Examiner rejected claims 10-11 and 12-22 under 35 USC §103 (a) as being unpatentable over Safai in view of Steinberg (US 6,006,039). The Examiner admits that Safai fails to teach the step of allowing the user to manually create the action list on the photo-sharing service website by navigating to the photo-sharing service website using a web browser and manually creating the action list. The Examiner cites Steinberg for disclosing a method for "allowing the user to manually create the [sic] entering of 'text and graphics'". The Examiner then states that it would have been obvious to create the action list, which consist of "text and graphics."

In response, Applicants point out that any conventional use of a web browser includes entering text and graphics, and the mere disclosure of text entering, without more, fails to teach or suggest that the content of the text is an action list that is downloaded to the camera, where the items on the list represent actions to be performed by the server, as recited in independent claims 1 and 12. In addition, a secondary reference stands or falls with the primary reference. Because Safai fails to teach or suggest an action list as claimed, a combination of Safai and Steinberg likewise fails to teach or suggest the claims of the present invention.

#### New Claim 23

It is respectfully submitted that the combination of references, alone or in combination, also fails to teach or suggest the recitations of new claim 23. For example, step (a) of claim 23 recites that the action list includes one or more items representing actions that the server should take with respect to uploaded images, “including any combination of specifying a storage location, sending the images to one or more email addresses; and analyzing or performing calculations on the images.” Although Safai teaches an email function whereby the server emails an uploaded image, Safai fails to teach an action list that includes a combination of the recited functions other than email.

Based on the foregoing, Applicant's attorney believes that this application is in condition for allowance. Should any unresolved issues remain, Examiner is invited to call Applicant's attorney at the telephone number indicated below.

Respectfully submitted,

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Date



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